

REMARKS

Claims 1-39 are pending in this application. Claims 4-39 are withdrawn from consideration as being drawn to non-elected inventions. Claims 1-3 are rejected. Claim 1 is amended. New claim 40 is added.

Support for the amendment to claim 1 is found on application page 3, lines 17 and 18, and in Table II on pages 32 and 33 of the application. Support for new claim 40 is found on pages 24 and 25 of the application. Support for new claim 41 is found on application page 6, line 20, and on page 24, line 20.

In consideration of the amendments and the following remarks, reconsideration of original claims 2 and 3, amended claim 1, and consideration of new claims 40 and 41 are respectfully requested.

Claim Rejections - 35 USC §102(b)

The Patent Office rejected claims 1-3 under 35 U.S.C. §102(b) as being anticipated by Plass et al. (Oncogene, May 20, 1999, volume 18, pages 3159-3165), hereinafter "Plass et al."

Applicant's amended claim 1 recites a method for identifying preferentially methylated CpG islands in malignant cells within a tumor or neoplasm from breast, colon, glioma, head and neck, lung, primitive neuroectodermal tumors (PNET) or testicle. Nowhere in Plass et al. are tumors or neoplasms from any of the tissues recited in applicant's amended claim 1 disclosed. Lacking such disclosure, Plass et al. does not anticipate applicant's amended claim 1. Original claims 2 and 3 depend from amended claim 1 and are likewise not anticipated by Plass et al.

The Patent Office also rejected claims 1-3 under 35 U.S.C. 102(b) as being anticipated by Costello et al. (Nature Genetics, February 2000, volume 25, pages 132-138), hereinafter "Costello et al."

With regard to Costello et al., the print publication date for this reference is February 2000. Because the reference was not publicly available before the February 2000 print publication date, it was not available more than one year prior to applicant's January 31, 2001 filing date and, therefore, is not an anticipating reference under 35 U.S.C. §102(b).

In support of this, although the Costello et al. reference is available online at the Nature Genetics Website (See, http://www.nature.com/cgi-taf/DynaPage.taf?file=/ng/archive/past_issue.html), pre-print access (before February 2000) of

this article was not available. The practice of the publisher of Nature Genetics is to indicate both the print and earlier online publication dates on its articles (See, <http://www.nature.com/ng/aop/>). No online publication date is indicated on any articles published in Nature Genetics before August 2001, indicating that no pre-print, online publication was available on articles, including the Costello et al. article, published prior to August 2001 (See, http://www.nature.com/cgi-taf/DynaPage.taf?file=/ng/archive/past_issue.html).

In addition, applicant has attached a signed Rule 1.132 Declaration (pursuant to *In re Katz* USPQ 14 (CCPA 1982)). The Declaration explains that Dr. Plass is the sole inventor of the subject matter recited in the claims of the application and that the other authors of the Costello et al. paper are not inventors of the recited claims.

It is submitted that original claims 2 and 3, amended claim 1 and new claims 40 and 41 are in condition for allowance. Prompt notice of such allowance is respectfully requested.

Respectfully submitted,

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